

REMARKS

Claims 1, 8, 10-13 and 26-39 are pending in the present application.

Restriction Requirement

The Examiner has required election in the present application between:

Group I, claims 8, 12, and 1, 13 and 26 in part, drawn to a compound wherein R1 is a 5-membered heterocyclic ring, a composition containing the compound and a process for making the compound;

Group II, claims 10, 38 and 1, 13 and 26 in part, drawn to a compound wherein R1 is a 6-membered heterocyclic ring, a composition containing the compound and a process for making the compound;

Group III, claims 11, 39 and 1, 13 and 26 in part, drawn to a compound wherein R is a bicyclic group, a composition containing the compound and a process for making the compound; and

Group IV, claims 27-35, drawn to multiple methods of using the compounds for treating diseases.

Applicants traverse this restriction requirement as being improper and withdrawal thereof is respectfully requested. The R1 substituents listed in claim 1 and designated in the restriction requirement as Groups I-III are effectively recited in claim 1 as members of a Markush group. As such, whether the present claims are restricted should be determined under the provisions of MPEP §803.02, which is nowhere cited in the Office Action. As stated by MPEP §803.02, "it is improper for the Office to refuse to examine that which applicants regard as their invention unless the subject matter in a claim lacks unity of invention of invention. *In re Harnisch*, 206 USPQ 300 (CCPA 1980)...unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility." Both are present in the present case, so the restriction is entirely without basis.

Regarding the compounds of Groups I, II and III, all of the compounds comply with requirement (1) above by having the shared common utility of being cholinergic ligands for nicotinic Acetyl Choline Receptors. See the Abstract. Regarding requirement (2) above, all of the compounds share a substantial structural feature with the structural core of formula (I) recited in claim 1. As such, withdrawal of the restriction requirement and rejoinder of the claims are respectfully requested.

Applicants further request that Group IV, being drawn to methods of using the compounds of claim 1 be rejoined as being drawn to a method of using compounds which are both novel and unobvious over the prior art.

For the purpose of examination of the present application, Applicants elect, with traverse, Group III, claims 11, 39 and 1, 13 and 26 in part wherein R1 is a bicyclic heterocyclic group.

Election of Species

The Examiner has further required an election of species to a single disease of Group IV to be examined with Groups I-III. Applicants traverse this election as being improper and withdrawal thereof is respectfully requested.

While claims 29-35 recite a number of different diseases or conditions to be treated with the compounds of the present invention, all of those treatments are tied to the same mechanism as recited in claim 27. Specifically, all the diseases/conditions to be treated in the present claims are responsive to the action of a nicotinic Acetyl Choline Receptor (nAChR) modulator. As such, it would not be an undue burden for the Examiner to search and consider all of the diseases because only a single mechanism of action needs to be considered. Withdrawal of the election of species is therefore respectfully requested.

In the event that the Examiner does not withdraw the election of species of Group IV, Applicants elect "pain" as a single species.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact MaryAnne Armstrong, PhD (Reg. No. 40,069) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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